



## UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
---------------	-------------	----------------------	---------------------

07/911,405 07/10/92 FENN

J 840.004

EXAMINER

NGUYEN, K

B5M1/1012

ART UNIT

PAPER NUMBER

12

PETER L. BERGER  
LEVISSOHN, LERNER & BERGER  
757 THIRD AVE., RM. 2400  
NEW YORK, NY 10017

2506

DATE MAILED: 10/12/94

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined  Responsive to communication filed on 07-28-94  This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

## Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice of Draftsman's Patent Drawing Review, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of Informal Patent Application, PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6. \_\_\_\_\_

## Part II SUMMARY OF ACTION

1.  Claims 1 - 187 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2.  Claims 1 - 66 have been cancelled.
3.  Claims \_\_\_\_\_ are allowed.
4.  Claims 67 - 187 are rejected.
5.  Claims \_\_\_\_\_ are objected to.
6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.
7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8.  Formal drawings are required in response to this Office action.
9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable;  not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been  approved by the examiner;  disapproved by the examiner (see explanation).
11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved;  disapproved (see explanation).
12.  Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14.  Other

## EXAMINER'S ACTION

Serial Number: 07/911,405

-2-

Art Unit: 2506

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 67-187 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

No patentable weight is given to the composition of matter because it lacks utility.

Applicant has asserted that the claimed composition of matter has utility in that it is used to produce information (see remarks of 07-28-1994, page 32, line 23 to page 33, line 17). However, the claimed composition is merely a product which is analyzed in a mass spectrometer. It is not used by the mass spectrometer. Rather, it is analyzed by the mass spectrometer to produce information.

A statement that a composition of matter can be analyzed by something to produce some information is not a showing of utility. Rather, it is merely a statement that the composition can be analyzed, regardless of whether its utility has been discovered.

Applicant's arguments filed July 28, 1994 have been fully considered but they are not deemed to be persuasive.

Applicant argues that the composition of matter is not an intermediate product.

Serial Number: 07/911,405

-3-

Art Unit: 2506

This argument is moot. The composition of matter may not be an intermediate product, but it still lacks utility because the composition of matter is merely a product analyzed by the mass spectrometer. It is not used by the mass spectrometer.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to Kiet T. Nguyen at telephone number (703) 308-4855.

[cn]

KN

October 3, 1994

  
PAUL M. DZIERZYNSKI  
SUPERVISORY PATENT EXAMINER  
GROUP 2500